

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John C. Harvey *et al.*

Application No.: 08/498,002

Confirmation No.: 9881

Filed: June 7, 1995

Art Unit: 2448

For: **SIGNAL PROCESSING APPARATUS AND
METHODS**

Examiner: Aaron Strange

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.182

Pursuant to 37 C.F.R. § 1.182, the assignee of this application, Personalized Media Communications, LLC (“PMC” or “Applicant”), hereby petitions the United States Patent and Trademark Office (“PTO” or “Patent Office”) for relief not otherwise provided for under the PTO rules. Specifically, Applicant hereby petitions the Director, under 37 C.F.R. § 1.182, to withdraw the recorded terminal disclaimer before the above-referenced patent application issues as a patent.

I. Standard for Requesting Withdrawal of a Terminal Disclaimer

MPEP § 1490 states that “if timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent.” It further notes that because a terminal disclaimer does not take effect until after a patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from the entry of a terminal disclaimer, which is no longer appropriate or proper, is properly available through a petition.

The filing and recordation of an unnecessary terminal disclaimer has been characterized as an “unhappy circumstance” in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968). Further, MPEP § 1490 states that “there is no statutory prohibition against nullifying or

otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues.” The PTO has held that the proper time—and indeed the only time—a terminal disclaimer may be withdrawn is prior to the issuance of a patent. *Decision Denying Petition, In re Reissue Application of Lee et al, Reissue Application No. 09/933,918*, March 21, 2005 (“*Lee Decision*”).¹ As demonstrated below, the Terminal Disclaimer filed in this application is no longer appropriate and should be withdrawn.

II. Factual Background

The Terminal Disclaimer in the above-referenced application was filed October 14, 1998 pursuant to 37 C.F.R. § 1.321(c) and disclaimed, in essential terms, the terminal part of the statutory term of any patent granted on the above-referenced application, extending beyond the earliest expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on any of the then co-pending applications of the Applicant, i.e., the earliest expiration date for any patent which issued on any of the then co-pending applications.

This Terminal Disclaimer was filed in response to a Final Office Action mailed January 6, 1998, requiring Applicant to respond to the so-called “Administrative Requirement”. This Requirement required the Applicant to either file a terminal disclaimer, to provide an affidavit attesting to the fact that no conflicting claims exist between co-pending applications, or to identify how all the claims in the instant application are separate and distinct from all the claims in the co-pending applications. At that time, Applicant chose to file the Terminal Disclaimer based on a clear understanding with the examiner handling this application that its filing would result in the issuance of a timely Notice of Allowance. No such Notice was then issued and further examination delays and suspensions have characterized the prosecution of this application for the last eleven years.

By way of background, in November 1998, one month after the Terminal Disclaimer was filed, nine co-pending applications had been allowed, the issue fee was paid in six applications, and numerous other applications included claims directed to subject matter indicated to be

¹ The *Lee Decision* is a Final Decision from the Commissioner for Patents denying a petition to withdraw a terminal disclaimer via reissue because “petitioner knew, or should have known, [the withdrawal] had to be requested prior to issuance of the original patent”. The *Lee Decision* further stated that “what is here controlling is that petitioner seeks to correct an issued patent”, not a pending application as here.

allowable. Nonetheless, despite the PTO's clear indication in 1998 that dozens of applications contained allowable subject matter and would issue shortly thereafter, only one application ever issued (*i.e.*, U.S. Patent 5,887,243) and the PTO reversed its earlier position, withdrew the remaining allowed applications from issue and subsequently suspended prosecution on all but two of Applicants' pending applications.

The subsequent eleven years of repeated delays has included at least five examiner initiated suspensions of prosecution in this application. The eleven year pendency of the above-referenced application and the related co-pending applications has also included: multiple Notices of Non-Responsiveness which were eventually withdrawn; multiple Notices of Abandonment which were eventually withdrawn; multiple appeals filed with the Board of Patent Appeals and Interferences; and multiple petitions and letters directed to the Director of the Technology Center and the Deputy Commissioner for Patent Examination Policy to advance prosecution of the above-referenced application and all the co-pending applications. The above-referenced application is quickly approaching its fifteen anniversary of the filing date.

III. Basis for Request for Withdrawal

The PTO indicated to Applicant in 1998—and Applicant believed at that time—that a Terminal Disclaimer in the above-referenced application would result in the issuance of a timely Notice of Allowance. The PTO then issued in March 1999 one of the then application as a patent (U.S. Patent 5,887,243) and now the Terminal Disclaimer filed in this application would have the effect of disclaiming the terminal part of any statutory term for this application to the term of the '243 Patent. By choosing to delay, unjustly abandon, suspend and otherwise delay the prosecution of the above-referenced application for over eleven years the PTO has effectively deprived Applicant of a significant portion of the term for any patent that may issue. For all these reasons, Applicant respectfully requests withdrawal of the Terminal Disclaimer in the above-referenced case.

The claims in the above-referenced application were amended on March 8, 2002 and further amended by an Examiner's Amendment to which the Applicant agreed on November 13, 2009. The Examiner allowed the claims in their current form via an *Ex Parte Quayle* Action mailed December 4, 2009. In Applicant's view, no question exists that the currently allowed claims of this application are patentably distinct from Applicant's issued patents and all its co-pending and allowed applications. In fact, the Examiner has already informed Applicants that

the Office has determined the allowed claims to be patentably distinct from the claims of Applicants' issued patents: U.S. Patents Nos. 4,694,490, 4,704,725, 4,965,825, 5,109,414, 5,233,654, 5,335,277 and 5,887,243. Thus, because the Examiner has indicated the current allowed claims of this application to be patentably distinct from U.S. Patent No. 5,887,243, the withdrawal of the Terminal Disclaimer would not be reopening the question of the propriety of the double patenting rejection of January 6, 1998, and should be thus granted.

Moreover, the above-referenced application is now, some twelve years later, once again in condition for allowance and subject to the same Administrative Requirement requiring Applicant to:

- (1) file terminal disclaimers in each of the related co-pending applications terminally disclaiming each of the other co-pending applications;
- (2) provide an affidavit attesting to the fact that all claims in the co-pending applications have been reviewed by applicant and that no conflicting claims exist between the applications; OR
- (3) resolve all conflicts between claims in the identified co-pending applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the identified co-pending applications.

Applicants have, in their Response to an *Ex Parte Quayle* Action filed February 3, 2010, chosen the third option (based on the current status of the claims). Accordingly, Applicant has now "resolve[d] all conflicts between claims in the identified co-pending applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the identified co-pending applications". Based on this showing, Applicants believe that they have shown that the Terminal Disclaimer was improvidently recorded and therefore Applicant respectfully requests that the PTO withdraw the Terminal Disclaimer.

In addition, many of the still co-pending applications have also since been suspended, amended, reexamined, allowed, withdrawn from allowance, appealed, and interviewed, thus further fundamentally altering the circumstances that necessitated the original filing of the Terminal Disclaimer over a decade ago. For all these reasons, Applicant respectfully requests withdrawal of the Terminal Disclaimer.

Please charge the petition fee in the amount of \$400.00 to Deposit Account No. 50-4494. Please also charge any shortage in fees due in connection with the filing of this communication to Deposit Account No. 50-4494, and please credit any excess fees to such deposit account.

Dated: February 22, 2010

Respectfully submitted,

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